

**REMARKS**

**I. Claim Status**

Claims 1-105 are pending. The Examiner has withdrawn claims 32-72 and 101-105 as non-elected in response to the Office Actions (Restriction/Election Requirement) of December 14, 2006, and March 30, 2007. No claims are amended herein.

**II. Priority**

Applicants submit herewith certified English translations of U.S. Provisional Application No. 60/412,853, filed September 24, 2002; U.S. Provisional Application No. 60/418,345, filed October 16, 2002; U.S. Provisional Application No. 60/418,357, filed October 16, 2002; U.S. Provisional Application No. 60/412,854, filed October 16, 2002; and U.S. Provisional Application No. 60/412,855, filed October 16, 2002, from which U.S. Patent Application No. 10/654,907 claims priority.

Applicants also note that a specific reference to the aforementioned U.S. provisional applications has already been made in the Initial Information Data Sheet filed concurrently with the application.

**III. Rejection Under 35 U.S.C. § 103**

The Examiner rejects claims 1-31 and 73-100 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,985,298 to Brieva et al. ("Brieva"). See Apr. 1, 2008, Office Action at 4-5. Specifically, the Examiner asserts that Brieva discloses compositions that contain wax, including synthetic beeswax, which the Examiner equates with Kester wax. See *id.* The Examiner points to Example 2, which discloses a mascara composition containing, among other things, beeswax and

synthetic wax, and concludes that it would have been obvious to substitute synthetic beeswax for the beeswax or synthetic wax. *See id.* at 5.

Applicants respectfully traverse the rejection for at least the following reasons.

Several basic factual inquiries must be made in order to determine the obviousness or non-obviousness of claims of a patent application under 35 U.S.C. § 103. These factual inquiries, set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966), require the Examiner to:

- (1) Determine the scope and content of the prior art;
- (2) Ascertain the differences between the prior art and the claims in issue;
- (3) Resolve the level of ordinary skill in the pertinent art; and
- (4) Evaluate evidence of secondary considerations.

The obviousness or nonobviousness of the claimed invention is then evaluated in view of the results of these inquiries. *Graham*, 383 U.S. at 17-18, 148 U.S.P.Q. at 467; *see also KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1730, 82 U.S.P.Q.2d 1385, 1388 (2007).

Indeed, to establish a *prima facie* case of obviousness, the Examiner must:

make a determination whether the claimed invention “as a whole” would have been obvious at that time to that person. Knowledge of applicant’s disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the “differences,” conduct the search and evaluate the “subject matter as a whole” of the invention. The tendency to resort to “hindsight” based upon applicant’s disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

M.P.E.P. § 2142. “The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.”

*Id.* It is important to note, moreover, that the prior art references relied upon in a rejection “must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention,” when such reasons are articulated by the Examiner. M.P.E.P. § 2141.03(VI); *see also Graham*, 383 U.S. at 17, 148 U.S.P.Q. at 467.

Here, the Examiner has not established a *prima facie* case of obviousness because the claimed invention as a whole would not have been obvious in view of Brieva when considered as a whole. Specifically, Brieva does not teach or suggest all the claim limitations. Moreover, one skilled in the art would not have been motivated to use a wax with the claimed physical characteristics, nor would one skilled in the art have reasonably expected that such a wax, as claimed, would have superior properties.

**1. Brieva does not teach or suggest using a wax having the claimed tack and hardness, nor would one skilled in the art been motivated to use such a wax**

The claimed invention requires that the composition comprise at least one wax having a tack of greater than or equal to 0.7 N-s and a hardness of less than or equal to 3.5 MPa. *See, e.g.*, Claim 1. Nowhere does Brieva teach or suggest using a wax with these specific physical properties. Brieva merely lists a number of possible waxes that can be used in the composition, without regard to their tack and hardness. *See* Brieva, col. 5, lines 58-65. In fact, many of the waxes listed in Brieva have a hardness that is outside the scope of the claims:

| Wax  | Hardness (MPa) |
|--|----------------|
| carnauba   | 6.88           |
| ceresin  | 7.84           |
| ouricury   | 9.50           |
| montan   | 6.64           |
| rice bran wax                                    | 9.43           |
| ozokerite  | 8.76           |
| hydrogenated jojoba wax                          | 8.62           |
| microcrystalline wax (Microwax HW from Paramelt) | 8.11           |
| candelilla wax                                   | 9.59           |

Further, the beeswax used in Example 2 in the present specification has a hardness of 3.68 MPa, which is outside the scope of the claims. See Specification as-published (U.S. Patent Application Publication No. 2004/0137020 A1) at ¶¶ [0190]-[0191]. Also, unlike the synthetic beeswax that was elected, Kester K 82 P, there are synthetic beeswaxes that have a hardness outside the scope of the claims, such as Cyclochem 326 A from Goldschmidt (hardness of 4.87 MPa).

Moreover, the M.P.E.P. explains that “[t]he fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a *prima facie* case of obviousness.” M.P.E.P. § 2144.08(II) (citation omitted). Rather, the Examiner must consider, among other things, the scope of the content of the prior art and whether one skilled in the art would have been motivated to select the claimed species or subgenus. See M.P.E.P. § 2144.08(II)(A)(1)-(4). Because there is nothing in

Brieva that would have motivated one skilled in the art to select the claimed species, Kester K 82 P, let alone any other wax having the claimed tack and hardness, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and the rejection should be withdrawn.

**2. Applicants have established unexpectedly improved results when using the claimed wax**

Applicants have also demonstrated that the claimed invention results in superior and unexpected results as compared with a composition containing a wax disclosed as suitable in Brieva. Specifically, Applicants prepared a composition according to the present invention (Example 1) and compared it to comparative compositions (Examples 2-6), which were identical except for the wax used. See Specification as-published at ¶¶ [0184]-[0193]. Relevant to the Examiner's rejection, Example 1 contained Kester K 82 P, a wax which falls within the scope of the claims, and Example 2 contained beeswax, which falls outside the scope of the claims.<sup>1</sup> See *id.* at ¶ [0191]. The viscosity and consistency index were measured and the stability was evaluated for all the compositions. See *id.* at ¶ [0185]. The experiments demonstrated that Example 1 "was stable and had the lowest viscosity and the lowest consistency." *Id.* at ¶ [0192]. In contrast, Example 2, "although stable, had a higher viscosity and a higher consistency than those of" Example 1. *Id.*

Accordingly, the results of the tests described in the specification demonstrate the unexpectedly significant improvements of using the at least one wax with the

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<sup>1</sup>The tack and hardness of the waxes were measured. See *id.* at ¶ [0190]. The Kester K 82 P used in Example 1 had a tack of 3.38 N-s and a hardness of 0.96 MPa,

properties as claimed. Neither the waxes with the claimed properties, nor the benefits associated with them are disclosed by Brieva.

Thus, for at least the aforementioned reasons, a *prima facie* case of obviousness has not been established and Applicants respectfully request that this rejection be withdrawn.

#### **IV. Double Patenting Rejection**

The Examiner provisionally rejects claims 1-31 and 73-100 on the grounds of nonstatutory obviousness-type double patenting as being allegedly unpatentable over claims 32-38 and 45-58 of copending Application No. 10/654,907. See Apr. 1, 2008, Office Action at 6-7.

Applicants respectfully request that the Examiner hold the double-patenting rejection in abeyance until the indication of otherwise allowable subject matter. Upon review of the remarks and arguments made in this paper, should the Examiner believe this application to be in condition for allowance, but for the double patenting rejection, Applicants respectfully request that the Examiner contact Applicants' representative at 202-408-4152 to discuss an appropriate resolution.

#### **CONCLUSION**

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

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while the beeswax used in Example 2 had a tack of 2.02 N·s and a hardness of 3.68 MPa, which is outside the scope of the claims. See *id.* at ¶ [0191].


If the Examiner believes a telephone conference could be useful in resolving any outstanding issues, she is respectfully urged to contact Applicants' undersigned counsel at (202) 408-4152.

If there is any fee due in connection with the filing of this Statement, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: June 10, 2008

By:   
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Aaron M. Raphael  
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**ATTACHMENTS:** Certified English translations of U.S. Provisional Application No. 60/412,853, filed September 24, 2002; U.S. Provisional Application No. 60/418,345, filed October 16, 2002; U.S. Provisional Application No. 60/418,357, filed October 16, 2002; U.S. Provisional Application No. 60/412,854, filed October 16, 2002; and U.S. Provisional Application No. 60/412,855, filed October 16, 2002. Please note that the certified English translations of these provisional applications are being e-filed in the order that they are listed here.